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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,042	12/14/2001	Ileana A. Leuca	10194.8011US1	7039
30083	7590	07/22/2005	EXAMINER	
PERKINS COIE LLP/AWS P.O. BOX 1247 SEATTLE, WA 98111-1247			JAGANNATHAN, MELANIE	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/017,042

Applicant(s)

LEUCA ET AL.

Examiner

Melanie Jagannathan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/31/02, 3/1/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the application for patent or inventor's certificate on which domestic priority is claimed, by specifying the application number, country, day, month and year of its filing.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5, 7-8, 13-15, 22-25, 27-29, of copending Application No. 08/994831. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 08/994831 essentially teaches the same steps/means as claims 1-19 of current application.

Even though claims 1,9 of current application are broadened by omitting certain limitations from claims 2, 22 of copending application such as the processor configured to identify a subscriber service associated with destination, a processor or a network element other than the source packetizes the information sent over the route, it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184(CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

Claims 2-5, 7-8, 10-12 of current application are rejected based on the same rationale given for the rejection of independent claim 1 of current application.

Even though claim 9 of current application is broadened by omitting certain limitations from claims 2, 22 of copending application such as the processor configured to identify a subscriber service associated with destination, a processor or a network element other than the source packetizes the information sent over the route, it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184(CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

Claims 10-12 of current application are rejected based on the same rationale given for the rejection of independent claim 9 of current application.

Even though claims 13, 16, 17, 19 of current application are broadened by omitting certain limitations from claims 13,15, 29, of copending application such as destination subscribes

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to a service associated with wired information transfer network, equipment at destination not configured to accept information from source via wired information transfer network alone, the stored characteristics include information indicating type of equipment at destination and identified subscriber service associated with destination, a processor or a network element other than the source packetizes the information sent over the route, it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184(CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

Claims 14-15, 18 of current application are rejected based on the same rationale given for the rejection of independent claims 13, 16, 17, and 19 of current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 9, 12, 13, 14, 16, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said processor" in line 9. There is insufficient antecedent basis for this limitation in the claim.

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Claim 9 recites the limitation "said received characteristics" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "said characteristics" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation ""said stored characteristics" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "said step of storing characteristics" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "said received characteristics" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "said stored characteristics" in line 13-14. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Csapo US 5,910,946.

Regarding claims 1, 9, the claimed system for managing routing of information from

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source to destination through a plurality of networks, wherein at least one of the networks is a packet network is disclosed by routing of telephone calls with devices coupled to PSTN (Figure 3, element 32) and performing Internet calls with devices coupled to communication network (element 31). See column 3, lines 17-46. The claim comprising routing processor for receiving a query signal from source specifying destination is disclosed by mobile subscriber initiates call by dialing a destination number which is captured by internet base station (Figure 5, step 501). See column 4, lines 11-13. The claimed query specifies the destination to which information will be routed and processor determines route for transmission of information based on routing query signal and at least one characteristic stored in memory is disclosed by control unit of base station accesses home location register to request identification of called party number (step 502) and if information can be found in HLR, the called party is reachable via Internet connection (step 508) and base station transmits packetized compressed speech to called party's address (step 510). See column 4, lines 31-39. See column 4, lines 14-39. The claimed memory for storing one or more characteristics of destination is disclosed by base station utilizing a home location register to request identification of called number.

Regarding claims 2, 6, 12, the claimed characteristic of destination includes information relating to equipment is disclosed by when mobile subscriber initiates call by dialing destination number, control unit (Figure 4, element 47) of base station accesses HLR and if requested called party number is not found in HLR, call request is considered by base station as mobile-to-land line equipment directed call. If number is found, it is considered to be mobile phone equipment and Internet call is established. See column 4, lines 11-34.

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Regarding claims 3-4, 10, the claimed source subscribes to fixed wireless service network is disclosed by users can be mobile subscriber (Figure 3, element 30).

Regarding claims 5, 11, the claimed destination subscribes to PSTN network is disclosed by possibility of mobile-to-land line equipment directed call. See column 4, lines 18-30, column 5, lines 33-37.

Regarding claims 7-8, the claimed digitized voice and DTMF signal is disclosed by compression of speech from PCM to packet form.

Regarding claims 13, 15, 16, 17-18, the claimed method for managing routing of information from source to destination through a plurality of networks, with at least one of the networks is a packet network and wherein each network is linked to at least one other network by a communication medium is disclosed by voice communication via interconnection of PSTN, Internet for telephones and mobile subscribers (Figure 3). See column 4, lines 11-45. The claimed receiving a routing query specifying the destination to which information will be routed at a routing processor is disclosed by control unit of base station accesses home location register to request identification of called party number (step 502) and if information can be found in HLR, the called party is reachable via Internet connection (step 508). See column 4, lines 14-39. The claimed memory for storing at least one characteristic of destination is disclosed by base station utilizing a home location register to request identification of called party number. The claimed determining route for transmission of information based on query signal, and based on stored at least one characteristic in memory is disclosed by base station retrieving information on called party number from HLR, determines internet based voice call as subscriber service is



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possible and base station transmits packetized compressed speech to called party's address (step 510). See column 4, lines 31-39.

Regarding claim 14, the claimed step of storing characteristic includes step of storing at least one address for destination is disclosed by HLR storing internet address of called party's base station. See column 4, lines 40-65.

Regarding claim 19, the claimed method for managing routing of information from a subscriber of a fixed wireless service network to a destination through a plurality of networks, with at least one of the networks is a packet network and wherein each network is linked to at least one other network by a communication medium is disclosed by voice communication via interconnection of PSTN, Internet for telephones and mobile subscribers (Figure 3). See column 4, lines 11-45. The claimed receiving a routing query specifying the destination to which information will be routed at a routing processor is disclosed by control unit of base station accesses home location register to request identification of called party number (step 502) and if information can be found in HLR, the called party is reachable via Internet connection (step 508). See column 4, lines 14-39. The claimed memory for storing information concerning at least one characteristic of destination is disclosed by base station utilizing a home location register to request identification of called party number. The claimed determining a transmission path for transmission of information based on query signal, and based on stored at least one characteristic in memory is disclosed by base station retrieving information on called party number from HLR, determines internet based voice call as subscriber service is possible and base station transmits packetized compressed speech to called party's address (step 510). See column 4, lines 31-39. The claimed sending a routing response signal from routing processor to

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subscriber and routing information over path is disclosed by after identification of called party, base station connects call request to local exchange (Figure 5, step 505), if determination is made call is to land-line equipment, via ISDN connection and when called party goes off-hook (step 506), the connection is established and base station begins transmission of PCM voice towards called party (step 507). If HLR has identified called party to be mobile subscriber, base station initiates internet based call (step 508) and when call set-up procedure indicates called party is ready for conversation, base station transmits packetized compressed speech to called party's address (step 510).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kimball US 5,953,322 discloses cellular Internet telephone.

Narayanaswamy US 6,295,457 discloses integrated cellular telephone base station with Internet gateway.

Xu et al. US 6,151,628 disclose direct wireless to network access.

Shtivelman et al. US 6,078,581 disclose Internet call waiting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Jagannathan whose telephone number is 571-272-3163. The examiner can normally be reached on Monday-Friday from 8:00 a.m.-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ

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